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In re Application of	:	
Klockseth et al.	:	DECISION ON
Application No. 09/367666	:	
PCT No.: PCT/AU98/00099	:	PETITION UNDER
Int. Filing Date: 18 February 1998	:	
Priority Date: 18 February 1997	:	37 CFR 1.47(a)
For: Pressure Compensating Valve	:	

This is a decision on the renewed petition under 37 CFR § 1.47(a) filed on 11 August 2000.

BACKGROUND

This international application was filed on 18 February 1998, claiming priority of an earlier application filed on 18 February 1997. A Demand electing the United States was filed on 10 September 1998, which was prior to the elapse of 19 months from the priority date. The International Bureau transmitted a copy of the published international application to the United States Patent and Trademark Office on 27 August 1998. Accordingly, the 30 month time period for paying the basic national fee in the United States expired as of midnight on 18 August 1999.

On 17 August 1999, applicants filed a Transmittal Letter for entry into the national stage in the United States. The Transmittal Letter was not accompanied by, *inter alia*, the required basic national fee and an unsigned declaration of the inventors.

On 03 November 1999, a Notification of Missing Requirements Under 35 U.S.C. 371 in the United States Designated/Elected Office (DO/EO/US) (Form PCT/DO/EO/905) was transmitted to applicant, indicating *inter alia* that "the current oath or declaration does not comply with 37 CFR 1.497(a) and (b) for the reasons indicated on the attached PCT/DO/EO/917." The Notification of Missing Requirements further required the submission of a surcharge under 37 CFR 1.492(e). Indicating that A Notification of a Defective Oath or Declaration (Form PCT/DO/EO/917) was transmitted therewith, indicating that the "oath or declaration does not comply with 37 CFR 1.497(a) and (b) in that it is not executed in accordance with 37 CFR 1.66 or 37 CFR 1.68."

On 06 March 2000, applicants filed the instant petition under 37 CFR 1.47(a), along with, *inter alia*, a petition and fee authorization for a three month extension of time under 37 CFR 1.136(a) and a declaration signed by inventor Goran Bertil Claes Berndtsson.

On 31 March 2000, a decision on petition was mailed to applicants. The petition was dismissed on the basis that applicants had not provided adequate evidence that non-signing inventors Mr. Jervmo and Mr. Klockseth "refuse to join" in the application or "cannot be found or reached after diligent effort" within the meaning of 37 CFR 1.47(a).

Applicants filed the a renewed petition on 30 May 2000.

On 08 June 2000, the renewed petition of 30 May 2000 was dismissed without prejudice on the basis that petitioner had not provided sufficient factual proof that missing joint inventors Jervmo and Klockseth refused to execute the application or cannot be reached after diligent effort.

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(h), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor. Petitioner has satisfied requirements (1) and (4).

With respect to requirement (2), the renewed petition is accompanied by "Exhibit A", which is a letter signed by June Maidens. Regarding Mr. Klockseth, the letter indicates steps which were taken to secure Mr. Klockseth's signature on assignment documents, but does not show steps taken in order to secure his signature on an oath or declaration of the inventors. Specifically, the letter indicates, that in a telephone conversation on 30 August 1999, "Mr. Klockseth stated that he was not prepared to sign any documents." This is not sufficient to establish his refusal to execute an oath or declaration because it appears from the evidence of record that the telephone conversation concerned an assignment document, not an oath or declaration of the inventors. Moreover, the letter indicates that "a copy of the declaration application was not sent to Mr. Klockseth's residential address as he had moved and we did not have any details of his then current address." This does not establish that he could not be reached after diligent effort because it is not alleged that any attempt was made to transmit an oath or declaration and a complete copy of the application to *his last known residential address*, as required by 37 CFR 1.47. Moreover, no attempt to reach him at his alleged current address or telephone number has been alleged. Accordingly, on the basis of the present record, it would not be appropriate to conclude that Mr. Klockseth "refuses to execute the application or cannot be

reached after diligent effort.”

With respect to Mr. Jervmo, the letter signed by June Maidens indicates that a single attempt was made to mail an unspecified set of “the documents” to his last known residential address, and that the envelope allegedly was not returned. There is no clear indication that “the documents” included the required set of documents (oath or declaration and complete copy of the application) as opposed to some other documents (such as assignment documents). Moreover, the alleged mailing does not amount to a “diligent effort” because no return receipt is alleged to have been requested, and because only a single attempted mailing has been alleged. Also, it is unclear whether the mailing was in fact to his last known address, since the documents were allegedly mailed to an address in Green Point, NSW, but the letter also states that “We believe Mr. Jervmo is still in Sweden.” Based on the evidence of record, it would not be appropriate to conclude that Mr. Jervmo “refuses to execute the application or cannot be reached after diligent effort.”

With respect to requirement (3), the petition does not clearly indicate what Mr. Klockseth’s last known address is, since it does not indicate whether the Corella Street address is in fact his last *known* address. Moreover, the statement that “We believe Mr. Jervmo is still in Sweden but have no knowledge of his address or whereabouts” calls into question whether his last known address is in Green Point, NSW, or whether it is in Sweden.

DECISION

For the reasons explained *supra*, the petition is **DISMISSED**, without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled “Renewed Petition Under 37 CFR 1.47.” No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, DC 20231, with the contents of the letter marked to the attention of the PCT Legal Office.



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